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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,950	02/12/2004	Tommy Rodrigues	FDN-2797	7092

7590 12/20/2007
Attn: William J. Davis, Esq.
GAF MATERIALS CORPORATION
Legal Department, Building No. 10
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EXAMINER	
GILBERT, WILLIAM V	

ART UNIT	PAPER NUMBER
3635	

MAIL DATE	DELIVERY MODE
12/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/777,950	Applicant(s) RODRIGUES ET AL.	
	Examiner William V. Gilbert	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-17, 19 and 21-52 is/are pending in the application.
- 4a) Of the above claim(s) 2, 6, 7, 32, 33 and 36-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 8-17, 19, 21-31, 40-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>5 July 07</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a First Action following a Request for Considered Examination. Claims 1, 3, 8-17, 19, 21-31, 34, 35 and 50-52 are examined.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05 October 2007 has been entered.

Claim Objections

2. Claims 1, 8 and 50 are objected to because of the following informalities: applicant claims a shingle having "an outermost bottom left corner and an outermost bottom right corner" (e.g. Claim 1, lines 4, 5) and then claims "at least one corner corresponds..." (e.g. Claim 1, line 5). It is unclear to the examiner whether the "at least one corner" is to be one of the

left or right outermost corners or a separate corner. In other words, proper antecedent basis should be provided if the applicant intends for the "at least one corner" to be one of the "outermost" corners. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 8-12, 16, 17, 19, 21-23, 25-31, 34, 35 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Bondoc et al. (U.S. Patent No. 6,105,329).

Regarding Claims 1, Bondoc discloses a shingle (Figure 5, generally) with an anterior layer (1) and a posterior layer (15), the anterior layer having a head lap (Figure 1, element 3) and a butt (Figure 1, element 4), an alignment notch (Figure 1, element 6), the shingle having outermost bottom left and right corners, and at least one corner (element "A" from attached Figure 5 from Bondoc, below) corresponds to the alignment notch.

Applicant should also respectfully see the claim objection above if the intent of the "at least one corner" is to be one of the "bottom left or right corners". Further, the phrase "corresponds to the alignment notch" provides no further structural limitation as to how the corner and notch relate. The definition of *correspond* is "to be consistent, compatible or harmonious" (*Webster's II Dictionary*, third edition: Houghton Mifflin, 2005.) By using this definition and the broadest reasonable interpretation, the bottom outermost corner(s) correspond with the notch in that they are compatible with each other.

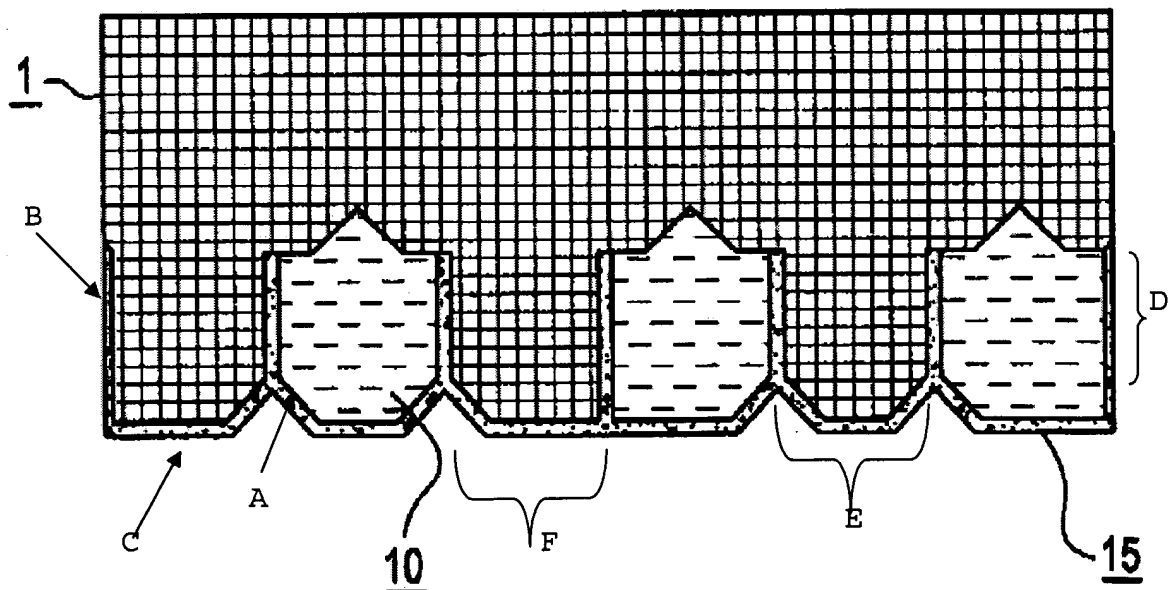


Figure 5 from Bondoc

Regarding Claim 3, the notch (6) has a triangle shape and a corner corresponds to a side of the triangle (element "A" from attached Figure 5 from Bondoc, above).

Regarding Claims 8, 29, 34, 35 and 52, Bondoc discloses a shingle with at least one layer (per Claim 29), a posterior layer (15, per Claims 8, 34, 35, 52) with a head lap (element "B" from attached Figure 5 from Bondoc, above, per Claim 8, 52) and tabs (element "C" from attached Figure 5 from Bondoc, above, per Claim 8, 52), an anterior layer positioned on the posterior layer (1, per Claims 8, 34, 35, 52), an anterior head lap (Figure 1, element 3, per Claims 8, 35, 52), an alignment notch (Figure 1, element 6, per Claims 8, 35, 52) and at least one anterior tab (Figure 1, element 2) positioned on the posterior tabs (per Claims 8, 52), and the anterior layer and posterior layer form a shingle, the shingle has outermost bottom left and right corners, and at least one corner that corresponds to the alignment notch (see "A" above: see rejection of Claim 1 above for argument addressing *corresponds*). The phrases "formed from...length", per Claim 29, line 1, "formed from...layer", per Claim 34 line 3 and "formed from...length" per Claim 35, line 3, "formed from...layer" per Claim 52 line 3 are statements of the

process of making the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of being made in this manner, then it meets the claim.

Regarding Claim 9, the alignment notch (6) is triangular shape.

Regarding Claim 10, there are four posterior tabs (see Figure 4, area proximate element 20).

Regarding Claim 11, the anterior and posterior tabs have first and second breadths respectively, and the second breadth is greater than the first breadth (see Figure 5 generally).

Regarding Claim 12, the anterior tab has granules of a first shade and the posterior tabs have a second shade (Abstract, lines 1-2 and 20-21; Column 4, lines 52-64).

Regarding Claim 16, the posterior tabs (element C above) extend beyond the anterior tab (2; see Figure 5, generally).

Regarding Claims 17, 19 and 21 the anterior head lap (Figure 9, area proximate element 40, per Claims 17, 19, 21) extends beyond the posterior head lap (Figure 9, area proximate element 44, per Claim 17) the anterior head lap edge aligns to a posterior head lap edge (Figure 9, element 48, see area

proximate element 42 where dotted line represents how the two headlaps may align, per Claim 19) and the posterior head lap extends beyond the anterior head lap (element "D" from attached Figure 5 from Bondoc, above, where the posterior head lap extends beyond the anterior headlap, per Claim 21).

Regarding Claims 22 and 23, Bondoc discloses two anterior tabs (Figure 8, element 60 per Claim 22) and three anterior tabs (Figure 8, element 60 per Claim 23).

Regarding Claim 25, the anterior tab (2) has a corner that corresponds to the alignment notch (see area proximate element A from attached Figure 5 above).

Regarding Claim 26, the posterior tabs (element "C" from attached Figure 5 from Bondoc, below) have corners (area proximate "A" above) that correspond to the alignment notch (6).

Regarding Claim 27, the anterior tab is positioned substantially centered on the posterior tab (element "E" from attached Figure 5 from Bondoc, above).

Regarding Claim 28, the anterior tab is positioned offset from the posterior tab (element "F" from attached Figure 5 from Bondoc, above).

Regarding Claim 30, the shingle has an anterior layer (1) and a posterior layer (15).

Regarding Claim 31, the phrase "formed from...length" per line 1 is a process for making the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of being made in this manner, then it meets the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc et al. in view of Elliott et al. (U.S. Patent No. 6,421,976) and Stahl et al (U.S. Patent No. 6,305,138) as in the action dated 29 September 2006.

Regarding Claim 13, Bondoc discloses the claimed invention except a shadow band positioned at an interface between the posterior tabs and headlap and a shadow tip on the lower edge of

the posterior tab of a third shade. Elliott discloses a shadow band (Figure 1, element 48) between the posterior headlap and tabs, and Stahl discloses shadowed tips (Figure 2, element 40; Column 3, lines 23-30). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to use the shading patterns in Elliott and Stall with the shingle in Bondoc because the shadings are aesthetic and provide no structural limitation to the claimed invention.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc in view of Stahl as in the action dated 29 September 2006.

Regarding Claim 14, Bondoc discloses the claimed invention except a shadow tip on the lower edge of the posterior tab. Stahl discloses shadowed tips (Figure 2, element 40; Column 3, lines 23-30). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to use the shading patterns in Stall with the shingle in Bondoc because the shadings are aesthetic and provide no structural limitation to the claimed invention.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc in view of Elliott as in the action dated 29 September 2006.

Regarding Claim 15, Bondoc discloses the claimed invention except a shadow band positioned at an interface between the posterior tabs and headlap. Elliott discloses a shadow band (Figure 1, element 48) between the posterior headlap and tabs (48). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to use the shading patterns in Elliott with the shingle in Bondoc because the shadings are aesthetic and provide no structural limitation to the claimed invention.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc as in the action dated 29 September 2006.

Regarding Claim 24, Bondoc discloses the claimed invention except the spacing of the posterior tabs. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to make the shingle in Bondoc with these dimensions because Applicant

failed to state a criticality for this spacing and the shingle in Bondoc is capable of being made in such a manner.

Claims 50 and 51 rejected under 35 U.S.C. 103(a) as being unpatentable over Bondoc.

Regarding Claim 50, Bondoc does not disclose a method of installing a shingle by affixing a shingle to the roofing area, affixing another course to the roof by aligning the cut corner of one course with the alignment notch of the previous course, and repeating the above steps until the roof is completely covered. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to install the shingle in Bondoc in this manner because the shingle in Bondoc has the alignment notch (6) and the shingle has outermost bottom left and right corners and the corner corresponds to the notch (see rejection of Claim 1 above for clarification), and the edge corner and alignment notch correspond to act as an alignment means.

Regarding Claim 51, only the method of installing the shingle is claimed. The phrase, "formed from...length" line 2 is a process for making the claimed invention and must result in a structural difference between the claimed invention and the

prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of being made in the claimed manner, then it meets the claim.

Response to Arguments

5. The following addresses applicant's remarks dated 10 July 2007.

Regarding applicant's remarks and amendments to the claims addressing the limitation "outermost bottom left and right corner" and "correspond with the alignment notch" (Remarks: page 11), see rejection of Claim 1 above.

Regarding applicant's remarks and amendment to claims 29, 34, 35 and 52 to address the fraction of the cutting cylinder, applicant should respectfully note the rejection dated 05 April 2007. The rejection states that these claims reference a process for making the claimed invention (the shingle). The reference to the fraction of the cutting cylinder is respectfully irrelevant because it is a reference to how the shingle is made, so regardless of the fraction of the cylinder,

only the final product, the shingle, is provided the patentable weight. As a result, no structural difference is present in the invention and the prior art of record.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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WVG

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14 Dec 07

[Signature]
Patent Examiner
12/14/07